

REMARKS

Specification

The specification has been objected to as failing to provide proper antecedent basis for the claimed subject matter of claims 26, 33 and 34. Although the Examiner's objection is now moot with the withdrawing of claims 26, 33 and 24, Applicant does not agree that the claimed subject matter of claims 26, 33 and 24 is not properly disclosed in the present application and reserves the right to claim the same in this or subsequent application.

The Examiner has also objected to the specification because "the identification of the anionic emulsifiers on page 8, paragraph 20 is incomprehensible". Applicant respectfully advises the Examiner that present application discloses certain types of anionic emulsifiers based on the classification nomenclature provided by the American Society for Testing and Materials (ASTM) and the American Association of State Highway and Transportation Officials (AASHTO), and as would be well known by those skilled in the art.

Claim Objections

Examiner has objected to claims 33 -34 and 36 -37 for being in improper dependent form and substantially duplicative therefore, respectively. Applicant has withdrawn from consideration each of claims 33, 34, 36 and 37 and respectfully submits that the Examiner's objections are now moot.

Rejections under 35 U.S.C. 112

Claim 1 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection for at least the following reasons.

Applicant has amended Claim 1 to remove the objected to terms and respectfully submits that the rejection under 35 U.S.C. §112 has been overcome.

Rejections under 35 U.S.C. 102(b)

Claims 1-22, 26, 27, 29-31 and 35-37 have been rejected under 35 U.S.C. 102(b) as being unpatentable over Rostler (U.S. Patent 3,592,788), Woodruff (U.S. Patent 3,651,000), Green (U.S. Patent 4,268,428), Blainpain et al. (U.S. Patent 4,997,868), Elias et al. (5,151,456), Batdorf et al. (U.S. Patent 5,330,795), Grubba (U.S. Patent 5,795,929), or Harlan (U.S. Publication

2002/0058734). Applicant respectfully traverses this rejection for at least the following reasons.

Anticipation under 35 U.S.C. § 102 requires the cited art teach every aspect of the claimed invention. *See, M.P.E.P. §706.02(a)*. In other words, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Rejection of Claims 1 and 16

Claims 1 and 16 have been rejected under 35 U.S.C. 102(b) as being unpatentable over the prior art cited above. Applicant respectfully traverses this rejection.

Without conceding to any of the rejections set forth in the outstanding office action, Applicant, has amended the claims of the present application to more clearly claim that which Applicant regards as the invention. Support for each of the amendments may be found in the specification generally and the figures associated with the present application.

Applicant respectfully traverses the 35 U.S.C. § 102 (b) rejection with respect to Claims 1 and 16 and respectfully submits that amended Claims 1 and 16 are patentably distinguishable over the prior art of record. Analogously,

Applicant respectfully submits that amended Claims 5 – 7, 25 and 32 similarly overcome the prior art, at least because of these Claims' ultimate dependence on patentably distinguishable amended base Claim 1 and 16.

Rejections under 35 U.S.C. 103(a)

Claims 1 – 37 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rostler (U.S. Patent 3,592,788), Woodruff (U.S. Patent 3,651,000), Green (U.S. Patent 4,268,428), Blainpain et al. (U.S. Patent 4,997,868), Elias et al. (5,151,456), Batdorf et al. (U.S. Patent 5,330,795), Grubba (U.S. Patent 5,795,929), or Harlan (U.S. Publication 2002/0058734). Applicant respectfully traverses this rejection for at least the following reasons.

35 USC §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Accordingly, MPEP 706.02(j) states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

references or to combine reference teachings. Second, there must be a reasonable expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

In response to Examiner's response for Applicant to "claim his real invention . . . which would overcome the cited art", Applicant, has amended the claims of the present application to more clearly claim that which Applicant regards as the invention. Support for each of the amendments may be found in the specification generally and the figures associated with the present application.

Since neither of the art cited above, alone or in combination, teach all of the claim limitations of Claims 1 and 16 of the present invention as stated hereinabove, the combination of prior art stated above cannot render obvious Claims 1 and 16 of the above present application.

Applicant thus respectfully submits that independent claims 1 and 16 are in condition for allowance. Further, Applicant respectfully submits that each of claims 5 – 7, 25 and 32 are allowable, at least by virtue of an ultimate dependence on allowable amended claims 1 and 16.


Conclusion

Applicant respectfully requests early and favorable action with regard to the present Application, and a Notice of Allowance for all pending claims is earnestly solicited. If the Examiner would like to further discuss the amendments made herein, Applicant would be appreciative of a phone interview.

Respectfully Submitted,

REED SMITH LLP

Date: May 24, 2005



Edward F. Behm Jr.
Registration No. 52,606
2500 One Liberty Place
1650 Market Street
Philadelphia, PA 19103-7301
(215) 241-7939

Attorneys for Applicant